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| EXAMINER | |
|---|---|
| NGUYEN, TRI V | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1751 | |

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/839,138 | HIRAGA, MASAKI | |
| | Examiner | Art Unit | |
| | Tri V. Nguyen | 1751 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *05/02/2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-22* is/are rejected.

7)☒ Claim(s) *9,10, 14,15, 18 and 19* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *05/02/2006*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Amendment*

1. In the amendment file on January 12, 2005, Claims 1,9-11 and 13-20 have been amended and Claims 21 and 22 have been added. The currently pending claims considered below are Claims 1-22.

### *Claim Objections*

2. Claims 9, 10, 14, 15, 18 and 19 are objected to because of the following informalities: Claims 9, 10, 14, 15, 18 and 19 recite "an another user". Appropriate correction is required.

### *Claim Rejections - 35 USC § 101*

3. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 17-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 17-20 recite a computer program that is considered a nonstatutory functional descriptive material.

### *Claim Rejections - 35 USC § 112*

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-6, 9, 14, 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitation "the other users" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 4 recites the limitation "the selection" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the selection" in line 2 and the limitation "the other users" in line 3. There is insufficient antecedent basis for these limitations in the claim.

Claim 6 recites the limitation "the users" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 9 recites the limitation "the above user" in line 7. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "the above user" in line 9. There is insufficient antecedent basis for this limitation in the claim.

Claim 18 recites the limitation "the above user" in line 8. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claim 22 is rejected under 35 U.S.C. 102(e) as being anticipated by Ng (US 6,405,175).

Claim 22: Ng discloses a method for providing points based on a retrieval of keywords, comprising:

a. providing information to a first user responsive to selection of keywords (col 5, lines 34-65—the products/services reviewed are considered as the keywords); and

b. assigning at least one point to a second user when the information was provided responsive to a keyword search created by the second user (col 8, lines 33-49).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1-3, 8, 9, 12-14, 17, 18 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (US 6,405,175) in view of Rothstein (US 2002/0188532).

Claim 1: Ng discloses a method of providing points based on a retrieval of keywords, the method comprising:

a. presenting keywords to a first user through a network, and storing keywords selected by the user into a user-by-keyword management table relating to the user (col 5, lines 34-65—the products/services reviewed are considered as the keywords);

b. presenting keywords to an advertiser through the network, and storing keywords selected by the advertiser into an advertiser-by-keyword management table relating to the advertiser;

c. searching the user-by-keyword management table and the advertiser-by-keyword management table for keywords when there has been a request for retrieving the keywords from a second user different from the first user through the network, and when the requested keywords have been registered both in the user-by-keyword management table and the advertiser-by-keyword management table, posting a retrieved result of the keywords and advertisement of the corresponding advertiser to the second user through the network (col 8, lines 33-49); and

d. giving points to the first user when the second user has referred to the advertisement, and storing these points into a user's-point management table relating to the first user (col 8, lines 33-49).

Ng does not explicitly disclose step b. Ng discloses the use of targeted advertising in conjunction with the products and services listed and searched by the user (col 15, lines 43-60). In an analogous art, Rothstein recites the use of keyword advertising by associating an ad with specific keywords chosen by the advertiser (page 2, parag. 25-37). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Ng with keyword advertising. One would have been motivated to optimize the efficiency of the targeted advertisement by focusing the selection and ensuing delivery of the advertisement to users who are more likely to purchases the items advertised.

Claim 2: Ng and Rothstein disclose the method of providing points according to the claim 1, wherein the points gained by the users are exchanged for a product or a service (Ng: col 9, lines 23-29).

Claim 3: Ng and Rothstein disclose the method of providing points according to the claim 1,

wherein the points consist of user points that are generated when the other users have retrieved the user-obtained keywords and advertiser points that are generated when the other users have referred to the advertisement (Ng: col 5, lines 4-9).

Claim 8: Ng and Rothstein disclose the method of providing points according to the claim 1, but do not explicitly disclose wherein the users who have registered the keywords can select a display on the Web or a transmission by e-mail as a method of presenting the advertisement to the other users. Rothstein discloses the use of either email or web page as a display means (page 2, parag 25-37). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Ng and Rothstein, with displaying the advertisement via an email or a web page since it was known in the art that different display channels are used to enhance the ways to reach the users.

Claim 9: Ng and Rothstein disclose a method of providing points comprising:

a. obtaining keywords that a user can obtain from a server through a network, and displaying the obtained keywords at a user's terminal (col 5, lines 34-65);

b. transmitting keywords that the user has selected from the user's terminal to the server (col 5, lines 34-65);

c. presenting results of retrieval by other user together with advertisement of advertisers corresponding to the keywords registered in the server to the other user, when an another user different from the above user has retrieved the keywords through the network; and

d. giving points to the user who has obtained the keywords, when the other user has referred to the advertisement (col 8, lines 33-49).

Ng does not explicitly disclose step c. Ng discloses the use of targeted advertising in conjunction with the products and services listed and searched by the user (col 15, lines 43-60). In an analogous art, Rothstein recites the use of keyword advertising by associating an ad with specific keywords chosen by the advertiser (page 2, parag. 31). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Ng with keyword advertising. One would have been motivated to optimize the efficiency of the targeted advertisement by focusing the selection and ensuing delivery of the advertisement to users who are more likely to purchases the items advertised.

Claims 12, 13 and 17 disclose the apparatus, the computer readable medium and the program of the method Claim 1 respectively. The prior art of et al. as set forth above in Claim1 is relied upon to reject Claims 12, 13 and 17.

Claims 14 and 18 disclose the computer readable medium and the program of the method Claim 9 respectively. The prior art of et al. as set forth above in Claim 9 is relied upon to reject Claims 14 and 18.

9. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng and Rothstein as applied to claim 1 above, and further in view of Marks et al. (US 2001/0051911). Claims 4-7: Ng and Rothstein disclose the method of providing points according to the claim 1, but do not explicitly disclose the various ways of charging for the keywords. Ng recites the use of heuristic rules to improve the obtained results (col 11, lines 43-60). Rothstein discloses an accounting manager to maintain the records of the transactions and the compensation information (page 2, parag. 25 and 35). In an analogous art, Marks et al. recites the use of

keyword advertising by associating an ad with specific keywords chosen by the advertiser in a search engine setting that includes different charged rates for each keyword (page 2, parag. 23-28). Furthermore, the fee structure is seen as a design decision which is given little, if any, patentable weight. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Ng and Rothstein to include a fee structure for charging the keywords. One would have been motivated to implement a payment scheme in order to attract advertisers by giving the advertisers a decision choice depending on the revenue, viewing experience and traffic stream pattern.

10. Claims 10, 11, 15, 16, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rothstein (US 2002/0188532) in view of Ng (US 6,405,175).

Claim 10: Rothstein discloses a method of providing points comprising:

a. obtaining keywords that an advertiser can obtain from a server through a network, and displaying the obtained keywords at advertiser's terminal (page 2, parag. 25-37);

b. transmitting keywords that the advertiser has selected from the advertiser's terminal to the server (page 2, parag. 25-37);

c. presenting results of retrieval of keywords by user together with advertisement of the advertiser to the user, when the user has retrieved the keywords (page 2, parag. 25-37); and

d. giving points to an another user who has obtained the keywords stored in the server, when the user who has retrieved the keywords have referred to the advertisement.

Rothstein does not explicitly disclose step d. Rothstein discloses compensating a third party for helping in the advertisement display (page 2, parag. 37). In an analogous art, Ng discloses the

use of targeted advertising in conjunction with the products and services referred by a first user and searched by a second user (col 5, lines 34-65 and col 15, lines 43-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Rothstein with keyword referral. One would have been motivated to optimize the efficiency of the targeted advertisement by compensating the referral effort of a user thus enhancing the delivery of the advertisement to users who are more likely to purchases the items advertised.

Claim 11: Rothstein discloses a method of providing points based on a retrieval of keywords, the method comprising:

a. displaying retrieved results of keywords together with advertisement of advertiser corresponding to the keywords at user's terminal, when the user has retrieved the keywords from the user's terminal through a network (page 2, parag. 25-37); and

b. giving points to an another user who has selected the keywords, when the keyword-retrieved user has referred to the displayed advertisement.

Rothstein does not explicitly disclose step b. Rothstein discloses compensating a third party for helping in the advertisement display (page 2, parag. 37). In an analogous art, Ng discloses the use of targeted advertising in conjunction with the products and services referred by a first user and searched by a second user (col 5, lines 34-65 and col 15, lines 43-60). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Rothstein with keyword referral. One would have been motivated to optimize the efficiency of the targeted advertisement by compensating the referral effort of a user thus enhancing the delivery of the advertisement to users who are more likely to

purchases the items advertised.

Claims 15 and 19 disclose the computer readable medium and the program of the method Claim 10 respectively. The prior art of et al. as set forth above in Claim 10 is relied upon to reject Claims 15 and 19.

Claims 16 and 20 disclose the computer readable medium and the program of the method Claim 11 respectively. The prior art of et al. as set forth above in Claim 11 is relied upon to reject Claims 16 and 20.

11. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rothstein (US 2002/0188532) in view of Marks et al. (US 2001/0051911).

Claim 21: Rothstein discloses a method for conducting charged-keyword selling to advertisers, comprising:

a. retrieving keywords for which registration of advertisers is possible (page 2, parag. 25-37);

b. disclosing the keywords as a list of charged keywords (page 2, parag. 25-37);

c. allowing the advertisers to select optional charged keywords from the list of the charged keywords and to apply for the registration of the charged keywords;

d. setting content of contracts made by the advertisers and a provider of the method (page 2, parag. 25-37); and

e. receiving advertising data corresponding to the charged keywords from the advertisers (page 2, parag. 25-37).

Rothstein does not explicitly disclose step c. In an analogous art, Marks et al. recites the use of keyword advertising by associating an ad with specific keywords chosen by the advertiser in a search engine setting that includes different charged rates for each keyword (page 2, parag. 23-28). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as taught by Rothstein to include a listing of charged keywords available to the advertisers. One would have been motivated to allow the advertisers to choose keywords in order to attract advertisers by giving the advertisers a decision choice to optimize the correlation with the targeted audience.

### *Response to Arguments*

12. Applicant's arguments, see pages 9-13, filed January 12, 2005, with respect to the rejection(s) of claim(s) 1-20 under 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Ng, Rothstein and Marks et al. (see rejections above).

### *Conclusion*

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri V. Nguyen whose telephone number is (571) 272-6965. The examiner can normally be reached on M-F 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Douglas McGinty can be reached on (571) 272-1029 and Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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